

Appl. No. : 09/992,867  
Filed : November 14, 2001

### REMARKS

In an action mailed December 7, 2005, the Examiner required restriction of prosecution to 1 of 8 groups of claims as follows.

- Group I Claims 1-7, drawn to a method of encoding and correlating data, classified in class 705, subclass 28.
- Group II. Claims 8-10, drawn to a method of encoding by a parts management system classified in class 705, subclass 51.
- Group III Claims 11-16, drawn to a method of decrypting and correlating data, classified in class 705, subclass 28.
- Group IV Claims 17-20, drawn to a method of bidding, classified in class 705, subclass 37.
- Group V Claims 21-27, drawn to a method of encrypting and correlating data, classified in class 705, subclass 28.
- Group VI Claims 28-32, drawn to a method of encoding and correlating data, classified in class 705, subclass 28.
- Group VII Claims 33-36, drawn to a system for utilizing a parts management system, classified in class 705, subclass 28.
- Group VIII Claims 37-41, drawn to a system for utilizing a parts management system, classified in class 705, subclass 28.

In response to this restriction requirement and to comply with the requirements of MPEP 818.03(b) and 37 C.F.R. § 1.143, Applicant provisionally elects to proceed, with traverse, with prosecution on the merits of Group V (Claims 21-27) drawn to a method of encrypting and correlating data.

### Criteria for Restriction

For restriction to be proper, "(A) [t]he inventions must be independent;" and "(B) [t]here would be a serious burden on the examiner if restriction is not required." See MPEP 803(I).

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**It Would Not Impose a Serious Burden to Examine All Claims**

The Examiner states that the recited groups are "are related as subcombinations."

MPEP §803 provides that "if a search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions" (emphasis added). Applicant respectfully submits that some or all of the recited groups can be examined together without imposing a serious burden on the Examiner.

For example, the Examiner asserts that there are 8 groups and lists 3 classifications: class 705, subclass 28; class 705, subclass 51; and class 705, subclass 37. A cursory search reveals that many patents in these classes cite multiple class and subclasses. The mere presence of more than one search group should not, by itself, be a serious burden on the Examiner, and Applicant rebuts the Examiner's *prima facie* case of serious burden.

**Utility of the Sub-Combination**

As support for the distinctiveness of the recited groups, the Examiner asserts that the "subcombinations are distinct from each other if they are shown to be separately usable. Each of the inventions has separate utility as listed above. See M.P.E.P. §806.05(d)." Applicant respectfully submits that the Examiner incompletely characterizes the applicable standard.

The complete standard is recited in M.P.E.P. §806.05(d), which reads "[t]wo or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually restrictable when the subcombinations do not overlap in scope and are not obvious variants" (emphasis added).

The Examiner has not addressed the complete standard, and Applicant accordingly submits that the Examiner has not satisfied the *prima facie* case of distinct subcombinations.

Moreover, Applicant respectfully traverses the Examiner's assertion of separate utility for one or more of the foregoing groups of claims. For example, the Examiner states that the subcombination of Group I, with Claims 1-7 is unique because "it provides separate utility, such as receiving project information from an architect." Applicant notes that this utility may also be present in Group III, see Claim 14, reciting "receiving from the architect a parts quantity...;" in Group V, see Claim 22, "wherein the first user is one of an architect...;" in Group VI, see Claim

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29, "wherein the first user is one of an architect...;" in Group VII, see Claim 34, wherein the first user is at least one of an architect ...;"and in Group VII, see Claim 38, "wherein the first user is at least one of an architect."

Accordingly, Applicant respectfully submits that the Examiner has not satisfied the burden of establishing the subcombinations have separate utility, and thus, the Examiner's restriction is not proper. As set forth in MPEP 806.05(c)(B), the Examiner must establish "the subcombination can be shown to have utility either by itself or in another materially different combination." As set forth in MPEP 806.05(c), "[w]hen these factors cannot be shown, such inventions are not distinct" for the purposes of creating "a serious search burden."

Applicant have provisionally elected Group V as described above to satisfy the requirements of MPEP 818.03(b) and 37 C.F.R. § 1.143. However, Applicant traverses the restriction requirement and respectfully request the Examiner to withdraw the restriction and to examine all of the claims on the merits.

#### Amendments to Claims

Prior to examination on the merits, please enter the amendments to the claims. Applicant notes that the status identifier of "Withdrawn-currently amended" is permitted under 37 C.F.R. § 1.121(c)(2).

#### **SUMMARY**

In view of the foregoing, Applicant submits that the application is in condition for examination on the merits, and respectfully requests the same.

If there is any further impediment to examination of the Application, Applicant requests the Examiner to call the undersigned attorney of record at the telephone number listed below to resolve any such impediment.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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